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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,796	08/01/2003	Mamoru Uchida	03560.003341.	1669
5514	7590	10/19/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			WOOD, KEVIN S	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2874	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/631,796

Applicant(s)

UCHIDA, MAMORU

Examiner

Kevin S. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**2<sup>nd</sup> NON-FINAL REJECTION**

***Response to Amendment***

1. This action is responsive to the Amendment filed 25 July 2005. Claims 1-13 have been cancelled and claim 14 has been amended. Claim 14 is the only claim pending in the application.

***Drawings***

2. The new drawings were received on 25 July 2005. These drawings are acceptable. The objection to the drawings is withdrawn.

***Allowable Subject Matter***

3. The indicated allowability of claim 14 is withdrawn in view of the newly discovered reference(s) to U.S. Patent No. 6,539,157 to Doi. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Cell phone components, such as a speaker,

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microphone, antenna, display, keyboard, and battery, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The specification has not discloses how the apparatus is constructed as a cell phone. Many essential components of a cell phone have been omitted.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,324,328 to Mehlhorn et al. in view of U.S. Patent No. 6,539,157 to Doi.

Referring to claim 1, the Mehlhorn et al. reference discloses a layered board including a first layer (1) capable of transmitting at least an optical signal; a second layer (6,7) capable of transmitting at least an electrical signal; an insulating layer (19,20) interposed between said first layer and said second layer; and a signal connecting path (D) penetrating said insulating layer, said signal connecting path establishing interconnection of the signal between said first layer and said second layer, and said signal connecting path having both a function of transmitting the electrical signal and a

function of transmitting the optical signal; means for transmitting and receiving a high-frequency signal (23,24); and means for processing the signal (23,24). See Fig. 1-7 of the reference along with their respective portions of the specification.

The Mehlhorn et al. reference does not appear to specifically disclose the apparatus constructed as a cell phone. The Doi reference discloses the use of layered printed circuit boards containing electrical and optical components for use within cell phones and many other applications, for the purpose for increasing speeds and performance. Since the Mehlhorn et al. reference and the Doi reference are both from the same field of endeavor, the purpose disclosed by Doi would have been recognized in the pertinent art of Mehlhorn et al. It would have been obvious to one having ordinary art at the time the invention was made to utilize the optoelectronic circuit carrier apparatus disclosed by Mehlhorn et al, within a cell phone, for the purpose of improving the speed and performance.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Wood whose telephone number is (571) 272-2364. The examiner can normally be reached on Monday-Thursday (7am - 5:30 pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin S. Wood



AKM ENAYET ULLAH  
PRIMARY EXAMINER